

## **REMARKS**

### **The Amendments**

Support for the new dependent claims 30-32 can be found in the specification, for example, at page 4, lines 1-6; page 5, line 34, to page 6, line 34; and in the Examples at page 28, lines 22-37, and page 29, line 21, to page 31, line 2.

The amendments do not narrow the scope of the claims and/or were not made for reasons related to patentability. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application.

### **The Obviousness-type Double Patenting Rejections**

The rejections of the claims for obviousness-type double patenting over Claims 1, 2 and 6 or claims 4 and 7 of Fujiki (U.S. Patent No. 5,952,397) in view of Boneberger (U.S. Patent No. 5,894,002), Hayashi (U.S. Patent No. 4,995,799) and Tensor (U.S. Patent No. 5,885,514), are respectfully traversed.

Initially, it is pointed out that claims 6-8 of Fujiki (U.S. Patent No. 5,952,397) have been disclaimed from that patent. Therefore, it is not appropriate to base a double patenting rejection upon these claims. Clearly, there can be no double patenting where the claims are no longer in the patent.

Further, it is urged that both obviousness type double patenting rejections are prohibited under 35 U.S.C. §121. As a result of the restriction requirement made in the parent application, Ser. No. 08/936,553, the USPTO has already established that claims drawn to a method of molding a replica are patentably distinct from claims drawn to an

apparatus for performing such method. The Fujiki claims 1-5 are directed to a composition which is used to make a mother mold which mother mold is used to perform the method of molding a replica (disclaimed claims 6-8 were directed to a method of making a mother mold used to perform the method of molding a replica). Certainly, if the USPTO has already established that claims to methods of making a replica are patentably distinct from claims to an apparatus for making the replica, it would be inconsistent to find that claims to a composition used to make a mold used in a method of making a replica are not patentably distinct from claims to an apparatus for molding a replica. Although the 35 U.S.C. §121 prohibition relates directly to claims which are actually restricted in a parent application, the spirit of the law is violated by the inconsistency of restricting the method and apparatus claims in the parent (thus, finding they are patentably distinct) and asserting double patenting here of apparatus claims over claims directed to compositions for carrying out the method. In fact, the claims to the compositions in Fujiki are even farther removed from the apparatus claims than the method claims from which the apparatus claims were previously restricted. Fujiki's compositions claims are compositions for preparing a mother mold used in the method, i.e., one further step removed from the apparatus. Certainly, if the composition claims had been presented in the parent application, they also would have been restricted from the apparatus claims. Accordingly, applicants respectfully submit that the double patenting rejections here are inconsistent with the previous restriction requirement in the parent application.

As an additional independent basis for traversing the obviousness-type double patenting rejections, it is urged that the rejections are improperly based on the disclosure of the Fujiki patent rather than on what is claimed. The statements of the rejections rely upon

the teachings in Fujiki's disclosure of its apparatus (e.g., the action states that: Fujiki and Boneberger are analogous prior art references as both pertain to transparent molds ..). But an obviousness-type double patenting rejection is not a 35 U.S.C. §103 obviousness rejection. The question for obviousness-type double patenting is whether the pending claims are an obvious variant of the claims of the existing patent. As stated in MPEP §804(III), a double patenting rejection is significantly different from a 35 U.S.C. §103 rejection because it must rely on a comparison with the claims in an issued patent, whereas an obviousness rejection can rely on a comparison with what is disclosed (whether or not claimed) in the issued patent.

Thus, the question is whether the current claims to an apparatus for molding a replica, having its various apparatus elements, is rendered obvious by the Fujiki claims to a silicone rubber composition. To be certain, the silicone rubber composition could be used in conjunction with the currently claimed apparatus to prepare a replica, but the composition itself does not render the apparatus obvious. While the use of secondary references is allowed to support obviousness-type double patenting rejections, they cannot be used in the same manner as in 35 U.S.C. §103 rejections. They can only be used to support a position that the patented claims suggest that the claims being examined are an obvious variant thereof. They cannot be used in a combination sense to supply missing elements not in the patented claims. The Fujiki claims are not to an apparatus, they do not recite any "means for casting or filling the mold cavity" or "means for irradiating light." Further, while they refer to a mother mold, they are not actually directed to a mother mold but merely recite in the intended use preamble that the composition is for templating a mother mold. The secondary references are not properly used in an obviousness-type double patenting rejection to fill in elements completely lacking in the claims upon which the double patenting rejection is

based. Regardless, the secondary references are all directed to very different apparatus for performing different functions and it would not have been obvious to combine the teachings of the secondary references to arrive at the features of the claimed apparatus (remembering that the Fujiki disclosure cannot be relied upon; only the claims, which recite no apparatus features).

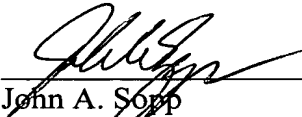
The larger question in assessing double patenting is whether the applicants are attempting to extend their monopoly by obtaining two patents on essentially the same subject matter. The patented claims to the composition are very different subject matter from the instant apparatus claims. Although the instant claims use the previously claimed composition to make the mother mold, the instant claims require further apparatus features and linkages between those features not required in the patented claims. To the contrary, the patented claims are directed to the composition, regardless of how it is used. Even the broadest language of the patent statutes, 35 U.S.C. §101, would put the claims at issue into two different classes of invention, i.e., machine (current apparatus claims) and composition of matter (Fujiki claims).

For all of the above reasons, applicants respectfully urge that the instant claims are not obvious variants of the still existing claims of the Fujiki patent. Accordingly, both of the obviousness-type double patenting rejections herein should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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John A. Sorp  
Registration No. 33,103  
Attorney for Applicants

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza I  
2200 Clarendon Blvd. Suite 1400  
Arlington, Virginia 22201  
Telephone: (703)243-6333  
Facsimile: (703) 243-6410  
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